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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/604,500	07/25/2003	Beth W. Ghiloni	F-728	1499
919	7590	03/24/2006	EXAMINER	
PITNEY BOWES INC. 35 WATERVIEW DRIVE P.O. BOX 3000 MSC 26-22 SHELTON, CT 06484-8000			ALPERT, JAMES M	
			ART UNIT	PAPER NUMBER
			3624	
DATE MAILED: 03/24/2006				

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/604,500

Applicant(s)

GHILONI ET AL.

Examiner

James Alpert

Art Unit

3624

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 22 December 2005.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-20 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-20 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____.
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____.

DETAILED ACTION

The following communication is in response to Applicant's amendment filed on 12/22/2005.

Status of Claims

Claims 3-4,7-10,12-15 are original. Claims 1-2,6,11,17,19 are currently amended. Claims 5,16,18,20 are previously presented. There are no canceled or new claims, so Claims 1-20 are therefore currently pending.

Response to Arguments

Applicant's arguments and amended claims have been fully considered but they are not persuasive as discussed below. Therefore, Claims 1-20 remain rejected, and Applicant's request for allowance is respectfully declined.

Provisional Application 60/315045

Until Applicant undertakes a formal challenge, the Examiner maintains, based upon cursory examination, that the provisional application is satisfactory to enable and support the utility application.

Claim Rejections - 35 USC §103

The text of 35 U.S.C §103, which is not included in this action, can be found in a prior Office Action.

Claim 1-3,6-8,11-13 & 16-20 are rejected under 35 U.S.C. 103(a) as being unpatentable over Piazza et al., U.S. Patent Application Publication 20030061358 in view of Crooks et al., U.S. Patent #6052671. Claim 4-5,9-10,14-15 are rejected under

Art Unit: 3624

35 U.S.C. 103(a) as being unpatentable over Piazza in view of Crooks and in further view of Barron's Dictionary of Computer and Internet Terms, 6th edition.

Applicant has amended the claims to read:

augmenting the detail information by adding charge-back fields related to the first user to create aggregated augmented detail information

Applicant argues that Piazza fails to include "charge-back" fields. While the word "charge-back" is generally known in the art to refer to a invalid, stopped or fraudulent charge, Applicant may act as his own lexicographer. See In re Paulsen, 30F.3d 1475, 1480, 31 USPQ2d 1671, 1674 (Fed. Cir. 1994) and Vitronics Corp. v. Conceptronic Inc., 90 F.3d 1576, 1582, 39 USPQ2d 1573, 1576 (Fed. Cir. 1996). However, Applicant must clearly set forth a definition of the term that is different from its ordinary and customary meaning. Without rendering an opinion as to whether Applicant has satisfied the legal requirements of the holdings above, the examiner understands Applicant's use of the terms "charge-back" fields to indicate data that relates to identifying a particular customer or vendor, or some other type of identifying information.

Paragraphs 23-27 described the process by which a user logs into the system to request reports that itemize charges according to some hierarchical organizational structure. Further Paragraphs 40-41 describe the way charges can be identified, including: cost center, personnel numbers, ID numbers, etc. This type of information appears to be the nature of "charge-back" related data to which Applicant refers.

Applicant further argues that the cited references do not teach:

requesting detail information regarding the charge from the first vendor referring to the indication; (underlining appears to presented by Applicant for emphasis)

As mentioned in the previous mailed final rejection, "charge-back" field data in Piazza is being acquired from somewhere, and it certainly cannot be the user. The vendor must be the source of the information. Further, since Applicant's claim does not specify the identity of the party requesting the information, the Examiner is well within reason to understand the claim to mean that the financial institution is requesting information, referring to an indicated charge, from the vendor. In that interpretation of the claim, this limitation is anticipated by ANY credit card transaction in that the financial institution processing the transaction always need some particular and detail information in order to process each charge.

Applicant also argues that there is a distinction between "pushing out" reports to a user in Piazza and "pulled" information from a vendor under Applicant's method. The Examiner does not agree with the characterization of the methods as so described. Under Piazza, a user can view aggregated, augmented, detail information sorted by the charge-back fields derived from the provided information. The information is must be accumulated from the vendor, either by the financial institution or some other means. Further, the terms "shipping" or "shipping tracking number" do not appear anywhere in Applicant's claims, and as such, are presently irrelevant to a discussion the cited art.

Specifically then, with regard to Claim 1, Piazza teaches the following steps:

receiving an indication of a charge from a financial institution by a first user of at least one vendor; (Paras. 53-54,75,Claim 16)

requesting detail information regarding the charge from the at least one vendor referring to the indication; (Paras. 23-27,40-41)

receiving detail information regarding the charge from the at least one vendor; (Paras. 28-33,36-38, 53-54,75-80)

Art Unit: 3624

storing and aggregating the detail information regarding the charge from the at least one vendor; (Paras. 28-33,36-38)

augmenting the detail information by adding charge-back fields related to the first user to create aggregated augmented detail information. (Paras. 23-27,40-41)

providing access to the aggregated augmented detail information;
(Paras. 23-33)

receiving selection data for the aggregated augmented detail information including charge-back fields related to the first user; and
(Para. 39, describing how vendor information can be further categorized and limited through a hierarchical structure; Paras. 23-27, describing the process of the user selecting various reports to be viewed which will detail various vendor charges)

With regard to the following limitation:

generating a bill based upon the selection data,

Piazza does not expressly disclose this aspect of the invention. However, Crooks, in the same field of endeavor, does teach presentation and generation of a bill based on selected items (Figures 10-12, showing selection of bills). Further, it would have been obvious to one of ordinary skill in the art at the time applicant's invention was made to modify the teachings of Piazza, relating to categorization and viewing of credit transactions by vendor and user, to include a bill generation feature as taught by Crooks. The motivation for such a combination is to decrease the amount of delinquencies and charge-offs by streamlining the posting, viewing, and billing process. **Claims 6 and 11**, representing a system and article of manufacture designed for carrying out the method, are similarly rejected.

With regard to Claim 2, stating:

tracking the inclusion of the charge on the particular bill, wherein a subset of charges are included on the particular bill and a remainder subset of the charges are included on at least one additional bill;

tracking the remainder subset on the at least one additional bill.

Applicant has argued that Piazza in view of Crooks does not teach tracking the inclusion of the charge on the bill. The examiner respectfully disagrees. Initially, as with Claim 1, Crooks establish a bill presentment system. This is generally recited in (Col. 2, lines 10-12): "Billing information is received from a billing entity and is associated with a bill for payment by the billable entity."

Once a bill is established, as in Claim 1, then the tracking of charges is fundamental to the method in Piazza. As generally related in (Para. 6),

"This ... method allow[s] Users to track all aspects of their charge spending through global and management information."

This aspect of Piazza is further detailed at (Para. 23-27 and 36-38). Applicant has amended the claims to recite additional separation of charges and tracking into subsets. This additional limitation is an obvious modification to any express teachings of Piazza, in that dated billing always includes some overlapping charges appearing on one bill, while later charges appearing on a subsequent bill. **Claims 7 and 12**, representing a system and article of manufacture designed for carrying out the method, are similarly rejected.

With regard to Claim 3, Piazza teaches a method comprising:

receiving an indication of payment of the bill and tracking a charge-back payment status of the charge. (Para. 84)

With regard to Claims 4, Piazza does not teach a method wherein:

selection data is received from an automated filter macro.

Although Piazza does not expressly teach a “filter macro” in the implementation of his system, Barron's Dictionary of Computer and Internet Terms teaches a macro as “a series of keystrokes that have been combined so they can be easily accessed.”

It would have been obvious to one of ordinary skill in the art at the time applicant's invention was made to modify the teachings of Piazza, relating to categorization and viewing of credit transactions by vendor and user, to include an automated filter macro as taught by Barron's. The motivation for such a combination is to decrease the amount of delinquencies and charge-offs by streamlining the posting, viewing, and billing process. **Claims 9 and 14**, representing a system and article of manufacture designed for carrying out the method, are similarly rejected.

With regard to Claim 5, Piazza does not teach a method comprising:

selection data is received from a user indication including a checkbox selection.

Although Piazza does not expressly teach a “checkbox selection” in the implementation of his system, Barron's Dictionary of Computer and Internet Terms teaches a checkbox as “a small box (in a window) that the user can turn on or off by clicking with the mouse.”

It would have been obvious to one of ordinary skill in the art at the time applicant's invention was made to modify the teachings of Piazza, relating to categorization and viewing of credit transactions by vendor and user, to include checkbox selection as taught by Barron's. The motivation for such a combination is to

decrease the amount of delinquencies and charge-offs by streamlining the posting, viewing, and billing process. **Claims 10 and 15**, representing a system and article of manufacture designed for carrying out the method, are similarly rejected.

With regard to Claim 16, Piazza teaches the method further comprising:

receiving a dispute indication from the first user regarding the charge from the first vendor.. (Para. 123)

With regard to Claim 17, Piazza teaches the method wherein:

the indication of a charge comprises a shipment tracking number, and wherein the at least one vendor is a shipping vendor and the charge-back fields include internal cost-center indentifiers.

(Para. 40, describing the variety of different search fields and filters that can be used in presenting billing data. Internal costs are clearly anticipated by Piazza.)

With regard to Claim 18, Piazza teaches the method wherein:

translating the detail information regarding the charge into a common charge format. (Para. 50, describing the ability to format information in any manner)

With regard to Claim 19, Piazza does not teach:

generating a bill based upon the selection data and parsed client information,

This claim, however, is rejected under a similar analysis as the seventh (7th) limitation in Claim 1. The only distinction is that the selection box choice is made based on parsed client information. This is inherent to method in Piazza that arranges billing information based on organizational structure, which is generally applied such that the charges of several employees are itemized and presented. Further, and relating to the following limitation,

wherein the charge-back fields include external client-matter identifiers

it is obvious that Piazza could be adapted for use in a system, which operates with external clients as opposed to a hierarchical structure of an organization. This is only a minor modification.

With regard to Claim 20, Piazza does not teach the method wherein:
the indication of a charge is received from an E-banking intermediary.

However, utilizing Internet technologies in processing financial information is decidedly old and well known in the electronic commerce arts. This being the case, it would have been obvious to one of ordinary skill in the art at the time Applicant's invention was made to include receiving charge information from an e-banking intermediary. The motivation for such a combination is to increase use of the system by making the system available to smaller networks and systems through easy Internet access and availability.

By way of reference, MPEP § 2144.03(C) states, in respect to an Examiner's use of Official Notice:

To adequately traverse such a finding, an applicant must specifically point out the supposed errors in the examiner's action, which would include stating why the noticed fact is not considered to be common knowledge or well-known in the art. See 37 CFR 1.111(b).

The same section continues:

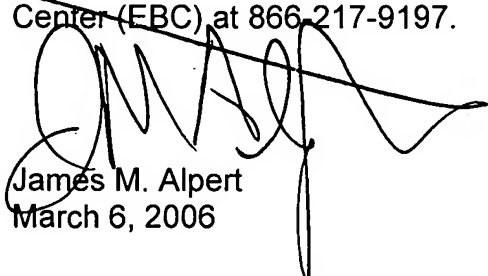
If applicant does not traverse the examiner's assertion of official notice or applicant's traverse is not adequate, the examiner should clearly indicate in the next Office action that the common knowledge or well-known in the art statement is taken to be admitted prior art because applicant either failed to traverse the examiner's assertion of official notice or that the traverse was inadequate. If the traverse was inadequate, the examiner should include an explanation as to why it was inadequate.

Applicant has not traversed the examiners noticed facts of Claim 20. The Examiner is now obligated to consider the facts of Claim 20 as admitted prior art.

Conclusion

THIS ACTION IS NON-FINAL. Any inquiry concerning this communication or earlier communications from the examiner should be directed to James Alpert whose telephone number is (571) 272-6738. The examiner can normally be reached on M-F 9:30-6:00. If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Vincent Millin can be reached on (571) 272-6747. The fax phone number for the organization where this application or proceeding is assigned is (571) 273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197.



James M. Alpert
March 6, 2006



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